ESTTA Tracking number: **ESTTA492042**

Filing date: **08/31/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200832
Party	Plaintiff Briggs & Stratton Corporation
Correspondence Address	ROBERT N PHILLIPS REED SMITH LLP 101 SECOND STREET SAN FRANCISCO, CA 94105 UNITED STATES ipdocket-chi@reedsmith.com, nborders@reedsmith.com, robphillips@reedsmith.com, ddaugherty@whdlaw.com
Submission	Other Motions/Papers
Filer's Name	Christopher R. Walker
Filer's e-mail	cwalker@whdlaw.com
Signature	s/Christopher R. Walker/
Date	08/31/2012
Attachments	Motion for Leave.pdf (7 pages)(218288 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRIGGS & STRATTON CORPORATION and KOHLER CO.,

Opposers,

v.

HONDA GIKEN KOGYO KABUSHIKI KAISHA,

Applicant.

Opposition No. 91200832 (parent)

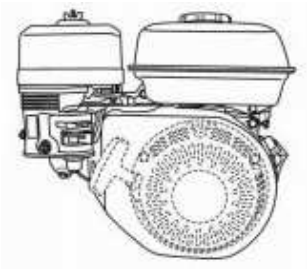
Opposition No. 91200146

Application Serial No. 78924545

MOTION FOR LEAVE TO FILE SUMMARY JUDGMENT MOTION REGARDING FUNCTIONALITY OF APPLICANT'S CLAIMED ENGINE CONFIGURATION

Extensive discovery produced by Applicant Honda Giken Kogyo Kabushiki ("Honda"), confirms that the subject Application seeks to register an overall cubic engine configuration that is functional as a matter of law. In light of this indisputable evidence originating from Honda's production, including Honda design memos, utility patents, and prior litigation testimony by Honda witnesses, this matter is now ripe for a motion for summary judgment on this dispositive issue. *See e.g. Secalt S.A. v. Wuxi Shenxi Construction Machinery Company, Ltd.*, 668 F.3d 677, 687 (9th Cir. 2012) (affirming grant of summary judgment that overall cubic shape of industrial machinery is functional and not protectable as a trademark, despite existence of alternative designs). Thus, Opposers respectfully request that the Board modify its August 24, 2012 suspension order to allow Opposers leave to file a motion for summary judgment on the grounds that Honda's claimed engine configuration is functional and cannot be registered as a trademark.

As the Board is aware, publication of Honda's application was twice revoked on functionality grounds.[1] Nevertheless, Applicant is now attempting to register the following drawing with this so-called "narrowed" description of the mark:



> "Color is not claimed as a feature of the mark. The mark consists of the configuration of an engine with an overall cubic design, with a slanted fan cover, the fuel tank located above the fan cover on the right, and the air cleaner located to the left of the fuel tank. The air cleaner cover features a cube shape with beveled top outside edges, and a belt-like area on the lower portion of the cover encompassing the entire circumference and the top of the belt-like area is aligned with a rib of the fuel tank. The carburetor cover features four ribs along its outside edge and a receded area where control levers are located. The fuel tank is roughly rectangular. The engine features a beveling that runs around its top circumference. The broken lining in the drawing is not part of the mark and serves only to indicate position. No claim is made to the exclusive right to use the design mark's purely functional components, namely levers, bolts, nuts and caps apart from the mark as shown."

U.S. Trademark Application Serial No. 78,924,545, available at http://tsdr.uspto.gov/ (accessed by searching for "78924545") (emphasis added). In their motion for summary judgment, Opposers will demonstrate that the above description remains erroneously overbroad in several respects. Honda's design documents, utility patents, and fact and expert witness testimony all confirm that:

1 – Honda owned a United States utility patent covering certain aspects of the claimed mark, including the overall cubic design and the placement and orientation of its main

[1] Publication of the subject Application was first revoked on August 15, 2007 -- for resolution as to what components of the drawing were not being claimed as part of the mark due to functionality principles -- and then again on July 29, 2008 -- following approval of a letter of protest on functionality grounds (finding that "a clear error has been made in allowing this mark

component parts, which expired in 2006 – the same year that Honda applied for the claimed mark. Honda also owned Japanese patents covering the functional aspects of the claimed overall cubic design.

2 – The "overall cubic design" makes the engine compact and minimizes the spaces it takes up within construction and other equipment.

3 – To minimize space, original equipment manufacturers typically design their products to incorporate engines having the same overall cubic design as claimed by Honda here, as shown in the images with No. 11 below.

4 – The "slanted fan cover" is designed to direct the flow of cold air to the hot part of the engine.

5 – The "fuel tank is roughly rectangular" so that it fits within the overall cubic design and to maximize the amount of available fuel to the user.

6 – The "fuel tank [is] located above the fan cover" to allow gravity flow of fuel into the engine, avoiding the cost of a fuel pump.

7 – The "air cleaner [is] located to the left of the fuel tank" because it needs to be in the front of the engine for safety and accessibility, and in close proximity to the carburetor below it for optimal performance.

8 – The "rib of the fuel tank" is created as a result of the crimping manufacturing process that binds together the top and bottom halves of the fuel tank, and Honda had an expired utility patent on the way the rib was made.

9 – The muffler cover (not shown in the drawing or referenced in the description) is placed behind the air cleaner cover 1) to fit within the overall cubic design, 2) for safety reasons

---

to be published").

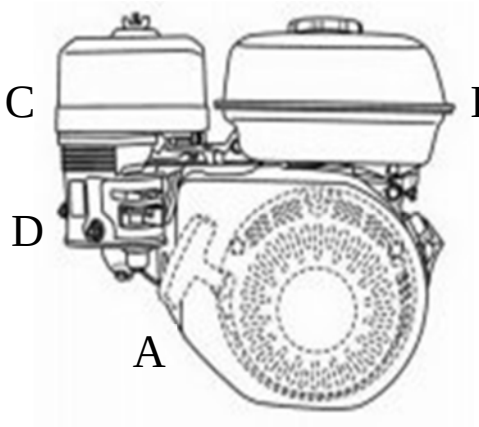
in placing the hottest part of the engine in the back away from the user (i.e. farthest from the starter cord and control levers), and 3) for operation reasons insofar as it should be close to the engine exhaust port. Further, the functional reasons for the position of the muffler cover necessarily limit the options for positioning the engine components that can be seen in the drawing and are referenced in the description.

10 – Honda designed the "receded area where [carburetor] control levers are located" to prevent the control levers from protruding out too far and getting accidentally moved or broken during operation of the equipment containing the engine.

11 – As seen in the images below, numerous third party engine manufacturers, including Robin Subaru, Briggs, Kohler, Lifan[2] and others, use the same general shape, placement, and orientation of the engine components discussed above to arrive at a functionally comparable engine design that can compete with Honda for sales to original equipment manufacturers.[3]

[2] An example of the Lifan engine can be found at Paragraph 7 in Opposers' Motion for Leave to File Amended Notices of Opposition, which was filed with the Board on May 30, 2012.

[3] Honda's lack of substantially exclusive use of the claimed overall configuration also precludes a finding of secondary meaning.



A. Slanted fan cover

B. Fuel tank

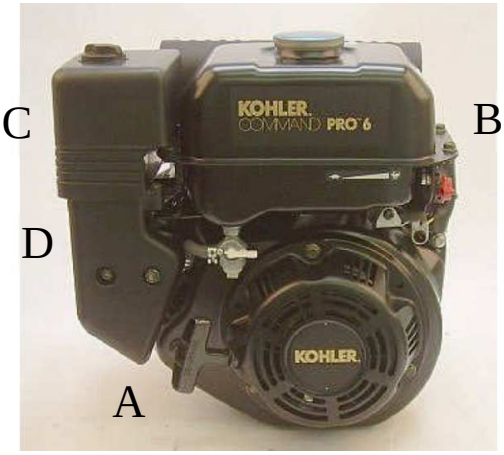
C. Air cleaner

D. Carburetor/controls

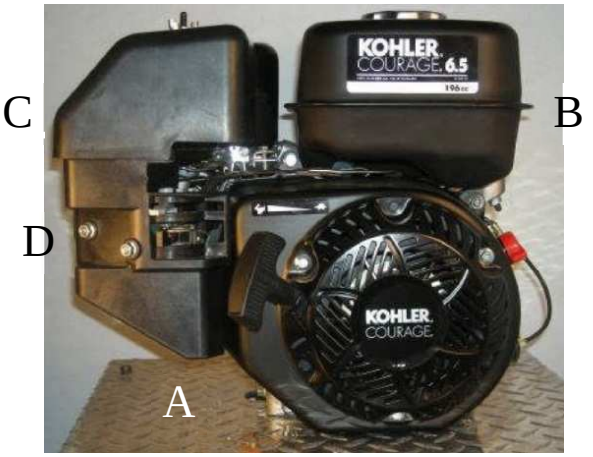
Image from Honda's U.S. Trademark Application Serial No. 78,924,545

Briggs & Stratton 750

Robin Subaru Ex 17



Kohler Command Pro 6



Kohler SH265

12 – The only potentially purely aesthetic design elements in Honda's engine design drawing above (i.e. the beveled top edges of the air cleaner cover and fuel tank, the belt like area on the bottom of the air cleaner cover, and the four ribs on the carburetor cover) were all eliminated or changed in a 2011 EPA Phase 3 redesign of Honda's GX engine for sales in the United States, and no longer fit within the description of the mark in Honda's application; all other functional aspects of the design were retained.[4]

The leave requested in Opposers' instant motion would allow the functionality issue to be brought before the Board without unnecessary delay, and open up the possibility for an early resolution of this dispute. The Board has recognized that the purpose of a summary judgment motion is judicial economy, and that the procedure is "a salutary method of disposition." TBMP § 528.06. Further, Opposers' grounds for rejecting Honda's application on summary judgment are firmly based in settled law. *See, e.g., TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995); *Secalt S.A.*, 668 F.3d at 677.

For the foregoing reasons, Opposers respectfully request leave to file their motion for summary judgment. If leave is granted, Opposers anticipate filing their motion by the end of September, 2012.

Dated: August 31, 2012

By: s/Robert N. Phillips
Robert N. Phillips
Seth B. Herring
Reed Smith LLP

[4] This evidence, along with Honda's express and implied consent to substantially similar third party engine designs, support Opposers' genericness and abandonment challenges, which are the subject of Opposers' pending motion for leave to file amended notice of opposition.

101 Second Street
San Francisco, CA 94105

and

Nina Habib Borders
Reed Smith LLP
1510 Page Mill Road, Suite 110
Palo Alto, CA 94304

Attorneys for Opposer Briggs & Stratton Corporation

Dated: August 31, 2012

By: s/Donald A. Daugherty, Jr.

Donald A. Daugherty, Jr.
Elisabeth Townsend Bridge
Christopher R. Walker
Whyte Hirschboeck Dudek S.C.
555 East Wells Street, Suite 1900
Milwaukee, WI 53202

Attorneys for Opposer Kohler Co.